## REMARKS

This application has been carefully reviewed in light of the Office Action dated September 9, 2004. Claims 1 to 9, 43 to 51, 67 and 68 remain in the application, of which Claims 1, 4, 7, 43, 45, 47, 49 and 67 are independent. Reconsideration and further examination are respectfully requested.

The specification was objected to for allegedly failing to provide antecedence for various claim elements. The objections are traversed since all claim elements are clearly described in the specification. More specifically, each of the elements of the apparatus claims can be found to correspond to the various computer hardware elements shown and described with regard to Figures 1 to 3, and each of the functional method/program step elements can be found to correspond to the various processes shown and described with regard to Figures 4 to 10. Nonetheless, without conceding the corrections of the objections, the language questioned in the Office Action has been amended to make it even clearer. Thus, withdrawal of the objections is respectfully requested.

Claims 7 to 9 and 45 to 48 were rejected under 35 U.S.C. § 101 as allegedly not being within the technological arts and for allegedly failing to produce a concrete, tangible result. The rejections are traversed since, for example, Claim 7 recited a step of displaying a user interface to enable the user to select a desired one of the designated pay service and a pay service other than the designated pay service which can be provided within the upper limit of the amount to be paid. Clearly, the foregoing is both within the technological arts and produces a concrete, tangible result of presenting the user interface for the user to select a service. Additionally, Claim 45 recited determining a plurality of

additional services that need additional charges other than a basic charge for the basic service but can be provided within the upper limit of the charge, outputting information of the plurality of additional services determined in the determining step, and providing the user with the basic service and at least one of the plurality of additional services as selected by the user. Again, the foregoing is clearly within the technological arts of print-for-pay services over a network and clearly produces a concrete, tangible result of providing a user with requested services. Thus, the rejections are traversed. However, the claims have been amended to more clearly define the subject matter contained therein and therefore, withdrawal of the § 101 rejections is respectfully requested.

Claims 1 to 9, 43 to 51, 67 and 68 were rejected under 35 U.S.C. § 112, second paragraph. Without conceding the correctness of the rejections with regard to alleged unclarity as to conjunctive or disjunctive selection of designated services, the language in question has nonetheless been cancelled from the claims, thereby obviating the rejections.

With regard to paragraph 14 of the Office Action, the allegation of an alternative § 112, second paragraph, rejection made therein based on § 112, sixth paragraph, is simply not understood. The Office Action appears to state that, if § 112, sixth paragraph, is to be invoked, a claim element that includes a "means for" phrase must also be linked and associated with corresponding structure. However, this assertion is contrary to well established U.S. patent law regarding § 112, sixth paragraph. In this regard, it is well established that a claim element that recites the phrase "means for" together with a corresponding function raises a presumption that § 112, sixth paragraph, is invoked. The presumption may, however, be overcome by a recitation of sufficient structure in the claim

to perform the claimed function such that, even though "means for" may be included in the element, § 112, sixth paragraph, is not invoked. Thus, as correctly stated at MPEP § 2181, a claim limitation will be interpreted to invoke § 112, sixth paragraph if it A) "use[s] the phrase 'means for' or step for'", B) "the 'means for' or 'step for' [is] modified by functional language", and C) "the phrase 'means for' or 'step for' [is] *not* modified by sufficient structure, material or acts for achieving the specified function." (emphasis added) Thus, the assertion made in the Office Action is contrary to the U.S. patent laws and therefore, the rejection is traversed.

Claims 1, 2, 4, 5, 7, 8, 49 and 50 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,878,401 (Joseph) or alternatively under 35 U.S.C. § 103(a) over Joseph, Claims 1, 2, 4, 5, 7, 8, 43 to 50, 67 and 68 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,119,099 (Walker), and Claims 1 to 9, 43 to 51, 67 and 68 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,826,244 (Huberman) or alternatively under 35 U.S.C. § 103(a) over Huberman. The rejections are respectfully traversed and the Examiner is requested to reconsider and withdraw the rejections in light of the following comments.

The present invention concerns controlling a print service provided over a network. According to the invention, an apparatus (such as a print-for-pay server) detects first print setting information for a first print service, and detects an upper limit of an amount designated by a user to be paid for the first print service. Then, the apparatus determines second print setting information for a second print service in accordance with the first print setting information and the upper limit. For example, the first print service

may be a basic request for printing a document and the upper limit may the amount of money that the user is willing to pay for such printing. The second print setting information may be, for example, additional services such as binding, color printing, etc., that can be provided to the user within the upper limit. The determined second print setting information may be displayed so the user can select the additional services, if desired, and then an output server than can process the requested job is selected. Thus, according to this aspect, a user can, if they so desire, select *both* the designated pay service *as well as* additional services that can also be provided within the entered limit.

Referring specifically to the claims, independent Claim 1 is a method of controlling a print service provided over a network, comprising the steps of detecting first print setting information for a first print service, detecting an upper limit of an amount designated by a user to be paid for the first print service, determining second print setting information for a second print service in accordance with the first print setting information and the amount of the detected upper limit, displaying the determined second print setting information, and selecting an output server in accordance with the second print setting information.

Independent Claims 4, 7 and 49 are system, memory medium, and system (written in non-means-plus-function form) claims, respectively, that substantially correspond to Claim 1.

Amended independent Claim 43 includes features along the lines of Claims 1, 4 7 and 49, but is directed more specifically to the server apparatus. Thus, Claim 43 is a print service control apparatus for controlling a print service provided over a network, comprising detecting means for detecting first print setting information for a first print

service and for detecting an upper limit of a charge entered by a user for the first print service, determining means for determining second print setting information for a second print service in accordance with the first print setting information and the upper limit of the charge, output means for outputting the second print setting information determined by the determining means, and selecting means for selecting an output server in accordance with the second print setting information.

Amended independent Claims 45, 47 and 67 are method, computer-readable medium, and apparatus (written in non-means-plus-function terminology), respectively, that substantially correspond to Claim 43.

The applied art is not seen to disclose or to suggest the features of amended independent Claims 1, 4, 7 and 43, 45, 47, 49 and 67. In particular, the applied art is not seen to disclose or to suggest at least the feature of determining second print setting information for a second print service in accordance with detected first print setting information for a first print service and a detected upper limit of a charge designated by a user to be paid for the first print service, or at least the feature of selecting an output server in accordance with the determined second print setting information.

Joseph is merely seen to disclose displaying a selected shoe type or an alternate shoe type. However, Joseph is not seen to relate in any way to print services and therefore, is not seen to disclose or to suggest at least the feature of determining second print setting information for a second print service in accordance with detected first print setting information for a first print service and a detected upper limit of a charge designated by a user to be paid for the first print service, or at least the feature of selecting an output server in accordance with the determined second print setting information. Accordingly,

Claims 1, 4, 7, 43, 45, 47, 49 and 67, as well as the claims dependent therefrom, are believed to be allowable over Joseph.

Walker is merely seen to disclose that a customer places an order for which a POS terminal determines the total sale price. The POS terminal then determines a rounded price and offers the customer upsells so that the final sale price will be a whole dollar amount. If the user accepts the upsell, the customer will receive either no change due, or change due only in whole dollar amounts, depending on the amount of money tendered. For example, a customer may order a hamburger and small soda for which the total cost is $1.62. The POS terminal determines a rounded price amount of $2.00, for which various upsell offers that would result in zero change being due back to the customer are determined. The upsell offers are then presented to the customer, and if the customer opts to add the upsell, the final total sale price is determined to be the rounded amount so that the user will either receive no change, or will receive change in whole dollar amounts instead of coinage. (See column 6, line 66 to column 7, line 35.) However, Walker, like Joseph, is not seen to relate to print service and is not seen to disclose or to suggest at least the feature of determining second print setting information for a second print service in accordance with detected first print setting information for a first print service and a detected upper limit of a charge designated by a user to be paid for the first print service, or at least the feature of selecting an output server in accordance with the determined second print setting information. Accordingly, Claims 1, 4, 7, 43, 45, 47, 49 and 67, as well as the claims dependent therefrom, are believed to be allowable over Walker.

Huberman is merely seen to disclose a brokered auction service for document services. According to the patent, the system includes a customer process, a supplier process and a broker process. A customer submits a document service request (e.g., bid) and the broker process acts as an intermediary to auction the services between various suppliers. Once a price has been established, the document request can be performed by the winning bidder. Thus, while Huberman may involve print for pay services, Applicant fails to see anything in Huberman in which second print setting information is determined for a second print service in accordance with detected first print setting information for a first print service and a detected upper limit of a charge designated by a user to be paid for the first print service. Accordingly, Claims 1, 4, 7, 43, 45, 47, 49 and 67, as well as the claims dependent therefrom, are believed to be allowable over Huberman.

In view of the foregoing amendments and remarks, the entire application is believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

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